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In the Claims:

Please amend claim 38 as follows:

Claim 38, line 6, change "adapted to be" to --for--.

Claim 38, line 7, change "coupled" to --coupling--.

REMARKS

Applicants wish to thank the Examiner for the courtesy extended to their representative during a personal interview conducted on February 8, 2000. The substance of the interview is discussed below to the extent it is pertinent to the arguments presented in this Amendment.

In the Office Action, the Examiner made the previous restriction requirement final and rejected claims 1, 11-13, and 38-41 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,455,409 issued to Smith et al. and either U.S. Patent No. 5,424,858 issued to Gillotte or U.S. Patent No. 4,376,936 issued to Kott.

By this Amendment, Applicants have amended the specification to correct informalities and have amended independent claim 38 as suggested by the Examiner during the interview to remove the "adapted to be" terminology.

**I. REJECTION OF CLAIMS 1, 11-13 AND 39-41 OVER THE SMITH ET AL. PATENT IN VIEW OF THE KOTT/GILLOTTE PATENTS**

Applicants respectfully traverse the rejection of claims 1, 11-13 and 39-41 under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 5,455,409 issued to Smith et al. in

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view of either U.S. Patent No. 4,376,936 issued to Kott or U.S. Patent No. 5,424,858 issued to Gillotte. For the reasons discussed below, Applicants submit that claims 1, 11-13 and 39-41 are allowable over the combination of cited references because the combined teachings of these patents fail to teach or suggest each and every element as now recited in these claims. For the reasons described in detail below, Applicants submit that one of ordinary skill in the art would not have considered modifying the Smith et al. system to incorporate the features of Kott or Gillotte. Further, even assuming that one would have been motivated to make such a combination, the combined teachings of Smith et al., Kott, and Gillotte fail to teach or suggest each and every element recited in some of the claims.

To enable the Examiner to readily refer between the pending claims and our remarks regarding those claims, Applicants have provided separate sections with headings for each set of claims subject to this rejection following a brief description of the Smith et al., Kott, and Gillotte patents.

#### **A. The Smith et al. Patent**

Smith et al. discloses an apparatus and method for monitoring the location of a plurality of computer tapes and for identifying the current location of a selected tape. More particularly, the apparatus includes at least one tape carrier (12a-12o, Fig. 6) each having a plurality of slots for receiving a tape cartridge. Each slot includes a contact pad 38 (Fig. 3A) including a plurality of electrical contacts for contacting corresponding contacts 22 (Figs. 1 and 3B) provided on the tape cartridge 10. Each tape cartridge includes a memory device for

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storing a unique volume/serial number identifying that tape cartridge. As shown in Fig. 13, the contact pad associated with each slot includes four contact terminals - two for receiving power, one for providing an enable signal to the memory device on the tape cartridge positioned within the slot, and one for receiving the unique volume/serial number from the memory device on the tape cartridge provided therefrom when an enable signal is sent to the contact pad associated with the slot in which the tape cartridge is located.

Each of the tape carriers 12 includes a microcontroller 300 that is coupled to a host computer 52 (Fig. 6). When a particular tape cartridge is to be located using this apparatus, the volume/serial number of the tape is input into host computer 52 and subsequently transmitted from the host computer to each of the control circuits 42 associated with the tape carriers 12. The microcontrollers 300 within the control circuits 42 respond to the tape request signal including the volume/serial number by polling the memories of each tape cartridge stored in one of its slots to determine whether a tape having the requested volume/serial number is present in the associated tape carrier 12.

To poll each of the tape cartridges, microcontroller 300 transmits an enable signal over a dedicated line 45b, 332, or 334 (Fig. 13) associated with a particular slot of the tape carrier. If there is a tape cartridge in that slot, its memory device responds to the enable signal by transmitting its volume/serial number to microcontroller 300 over line 45a, which is commonly connected to all of the slot contact pads. By knowing which slot it last sent an enable signal to, microcontroller 300 knows which slot a received volume/serial number corresponds to, and thereby stores the received volume/serial number in its memory at an address location

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dedicated to that particular slot. Microcontroller 300 then sequentially and separately enables the memory devices of each tape cartridge stored in one of its slots and stores the volume/serial number sent by those tape cartridges in memory address locations associated with each respective slot.

Once polling is completed, microcontroller 300 compares the requested volume/serial number received from host computer 52 to the volume/serial numbers stored in its memory. If the requested volume/serial number is not found in its memory, microcontroller 300 does not respond to host computer 52. If microcontroller 300 determines that the requested volume/serial number corresponds to a volume/serial number stored in its memory, microcontroller 300 signals host computer 52 by identifying itself to host computer 52 and then illuminates a lamp positioned on the front of the tape carrier that is associated with the slot in which the requested tape is located. Meanwhile, host computer 52 displays the identification of the tape carrier whose microcontroller responded to the tape request.

#### **B. The Kott Patent**

The Kott patent discloses a docket card-locating device whereby each docket card folder includes a memory having a unique code stored therein, and an indicator light that is illuminated when a control signal is sent over a conductive rail upon which the docket card folders are hung that includes the code stored in the memory for that docket card folder. The Kott device, however, does not disclose that the devices on each docket card folder can, in any way, send reply signals back to the control circuit. Further, the Kott device does not maintain

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any form of database including the identification codes of the docket cards contained within the docket card box.

Although it is not very clear how exactly the Examiner believes that one of ordinary skill in the art would have constructed a system based upon the combined teachings of Smith et al. and Kott, it is apparent that there are certain features of Kott that one of ordinary skill in the art would not have considered implementing in the Smith et al. system since it would destroy some important functions that are performed by the Smith et al. system. For example, because the Smith et al. system utilizes a dedicated and separate line for each tape and indicator light, the Smith et al. system does not transmit the identification code of the tape to the tape itself or to the indicator light at any time. Although the Kott patent does require that the code for the file be transmitted to the indicator device mounted on the docket card folder, the fact that the Kott docket card box does not allow for the docket card folders to transmit their identification codes back to a processing circuit, would destroy the ability of the Smith et al. system to determine the location of a particular item in a plurality of such retainers if the particular implementation in Kott were somehow used in the Smith et al. system.

### **C. The Gillotte Patent**

The Gillotte patent discloses a system for locating file folders. It discloses a shelving unit having a pair of electrical conductors for providing power to the signal means 22 on each folder. The signal means 22 receives and transmits data to a remote computer. The electrical conductors 24 and 26 are only provided for the supply of power to the signal means 22. No

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data is transmitted on these conductors. Additionally, the electrical conductors 24 and 26 are not coupled to a processor.

It is not at all clear how or why one skilled in the art would modify the Smith et al. system based on the teachings of Gillotte. Furthermore, if Smith et al. were modified based on the teachings of Gillotte, it would not recite all the features recited in the pending claims. Specifically, the processor would no longer be coupled to the folder retainer by a bus, as recited in claim 1. With respect to claim 38, the resultant system would not include a folder retainer having electrical contacts communicatively coupled to a processor.

#### **D. Claim 1**

Independent claim 1 defines a file tracking system comprising a combination of elements including at least "a plurality of file folders, each file folder including an addressable device adapted to be electrically connected to said bus when the file folder is placed in said folder retainer, each addressable device being responsive to a control signal including the unique address associated with the addressable device to transmit a signal back to said processor so that said processor may maintain the file location of each file in said database."

This aspect of the present invention contributes to the system's ability to track the location of files, particularly when a hierarchy of addressable switches is employed for each folder retainer. Specifically, the processor may locate a requested file by activating the bus segments between the processor and the last known location of the requested file (including the segment of the bus in a particular folder retainer), transmitting a control signal including the

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unique identification code of the file on the activated segments of the bus, and awaiting receipt of a return signal from the requested file folder that indicates that the requested file folder is located in the folder retainer having its connecting bus segment activated at that time. If no return signal is received, the controller sequentially activates each segment of the system bus until a return signal is received.

The Smith et al. patent does not disclose or suggest the need to transmit a unique address of a particular tape cartridge to the tape itself over the dedicated line. Because the memory enable signal that is sent by the processor in Smith et al. to each tape cartridge is sent over a separate isolated dedicated line, there is absolutely no need to transmit the unique identification of the tape cartridge over that line to cause it to respond by transmitting its volume/serial number back to the processor. Further, because the processor does not access a database prior to sending a polling signal, it would not know which volume/serial numbers to transmit over each dedicated line, nor would it know how to obtain a response from a tape cartridge that was newly added into a tape carrier slot since it would not know its volume/serial number to begin with. Thus, Smith et al. does not teach or suggest that each addressable device on the tape carriers be responsive to a control signal that includes the unique volume/serial number associated with that tape to transmit a signal back to the processor, as required by independent claim 1. As stated above, there would have been no reason why one skilled in the art would have considered modifying the Smith et al. system based on either Kott or Gillotte, and even if such motivation existed, the resultant system would not include all the features of claim 1.

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**E. Claims 11-13**

Claims 11-13 depend from independent claim 1, which was discussed above.

Applicants submit that these claims are allowable for the same reasons that independent claim 1 is believed to be allowable based upon their dependence upon independent claim 1 and because there would have been no reason why one of ordinary skill in the art would have considered modifying the Smith et al. system to include the common communication path of Kott for transmitting signals to the addressable devices on the docket card folders or the RF transmitters of Gillotte. Applicants' basis for this conclusion is stated above in the immediately preceding section. Therefore, Applicants respectfully submit that claims 11-13 are allowable over the teachings of Smith et al. and Kott or Gillotte whether considered alone or in combination.

**F. Claims 38-41**

Independent claim 38 is directed to an electric file tracking system that includes the features presented in original independent claim 1 except for a bus, and further recites that each file folder includes a conductor located on the file folder and is configured so as to electrically couple the addressable device on each file folder to the electrical contacts of the folder retainer when the folder retainer is positioned in any one of several different positions, wherein the conductor (which couples the addressable device to the processor) is configured to electrically couple the addressable device to the electrical contacts of the folder retainer at a plurality of locations on the file folder. None of the cited references teaches or suggests this feature. Specifically, in Smith et al., the tape cartridges do not include conductors that are

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configured to couple the memory device to the contacts in the tape carrier when the tape is positioned in one of several different positions. Clearly, the slots and tape cartridges are dimensioned such that the tape cartridges may not be positioned in the tape carrier in more than one position such that electrical contact could still be made. The Kott reference does not disclose that the electrical contacts on the docket card folders would continue to make contact if the position of the docket card folder were in any different position than that disclosed in the patent. The Gillotte patent does not disclose that such electrical conductors electrically couple the addressable device to the electrical contacts of the folder retainer, which, in turn, are coupled to the processor.

For these reasons, Applicants respectfully submit that independent claim 38 as well as claims 39-41, which depend therefrom, are allowable over the teachings of the cited references.

## **II. The Restriction Requirement**

In the Office Action, the Examiner indicated that claim 38 belongs in a separate group from claims 39-41. However, the Examiner nevertheless made a rejection of claim 38. It is noted that each of claims 39-41 is dependent upon claim 38. To the extent the Examiner has intended to restrict claim 38 from its dependent claims 39-41, Applicants do not understand the basis for doing so. Clearly, there is no burden on the Examiner to simply examine claim 38 along with elected claims 39-41 since it recites the common features of claims 39-41. In this regard, Applicants further question why the Examiner has restricted claims 14-18 from

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claim 12 since each of claims 14-18 depend from claim 12. Claims that are dependent from another claim cannot be considered to be subcombinations of that claim nor can the claim from which they depend be considered a subcombination of its dependent claims. Obviously, each of the dependent claims includes all the features of the claim from which they commonly depend. Thus, claim 38 and claims 39-41 cannot be considered separate subcombinations, nor can claims 14-18 and claim 12 be considered separate subcombinations. Similarly, claim 42 should be regrouped with claim 34 from which it depends and claims 61 and 62 should be regrouped with claim 54.

Aside from those more specific issues, Applicants submit that the Examiner's application of the rules for restriction relative to the claims of this application are improper because the Examiner has not applied both the requirements for election of species and the requirements for restriction between subcombinations. In the Office Action, the Examiner simply contends that all arguments regarding a species election requirement are moot, since no such election requirement was given. However, the Examiner cannot avoid the requirements pertaining to election of species by simply not making such an election of species. If subcombinations are species under a claimed genus, the Examiner must apply both standards (MPEP 806.05(d)).

In view of the foregoing remarks, Applicants submit that the present invention as defined in the pending claims is allowable over the prior art of record. The Examiner's

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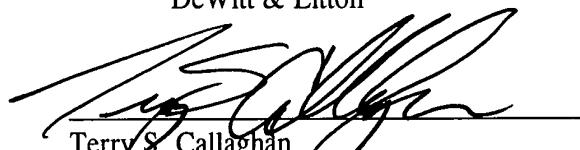
- reconsideration and timely allowance of the claims is requested. A Notice of Allowance is therefore earnestly solicited.

Respectfully submitted,

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